Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-21, 23, 24, 27, 29-37, and 39 are pending in the application, with claims 1, 15, 17, and 23 being the independent claims. Claims 1 and 15 are sought to be amended. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Rejections under 35 U.S.C. § 103

Erlin in View of Hurta and Chaney

Claims 1, 4, 5, and 10-14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,870,155 to Erlin (hereinafter "Erlin") in view of U.S. Patent No. 6,317,721 to Hurta *et al.* (hereinafter "Hurta") and U.S. Patent No. 5,473,609 to Chaney (hereinafter "Chaney"). (*See,* Office Action at pp. 2-4 and 7.) Applicants respectfully traverse these rejections.

Amended independent claim 1 recites, *inter alia,* "means for interacting with a user's credit or bank card . . . and, separate from said means, a further interacting means for interacting with a user's smartcard to read second information carried by the user's smartcard, said second information being modifiable remotely[.]" None of Erlin, Hurta, or Chaney discloses, teaches, or suggests all these features.

The Office Action fails to establish a prima facie case of obviousness. The Office Action concedes that "Erlin does not disclose the use of a user's smart card[.]" (Office Action at p. 2.) The Examiner, however, has cited Hurta for teaching a smartcard. Hurta teaches a smartcard for use with an automatic tell machine or ATM but makes no suggestion of its use with a remote center that broadcasts a television or radio program or data. Neither does Hurta teach a *remote* center that modifies information on a smartcard. Chaney does not teach or suggest any means for interacting with a credit card.

Thus, not only does none of the cited reference teach all of the claimed elements, none of the cited references even makes any suggestion that such a combination of elements would be desirable. In making the rejection, it appears to Applicants, that the Examiner is picking and choosing elements from different, unrelated references and is combining these elements to reconstruct the invention. Since there is no teaching or suggestion in any prior art document to make such a combination of references, Applicants assume that the Examiner is using Applicants' own claims as the blueprint or roadmap for making the combination. This use of Applicants' own disclosure to reconstruct the claimed invention is impermissible. "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." (M.P.E.P. § 2142.)

If Applicants' understanding of the cited art is incorrect, Applicants respectfully request that the Examiner specifically point out where (in any of the cited references) is the teaching or suggestion that would motivate a person skilled in the relevant art to make

the claimed combination. Absent some teaching or suggestion, Applicants respectfully submit that the rejection is improper and ask that it be reconsidered and withdrawn.

Furthermore, Hurta, which is directed to Automatic Vehicle Identification and is intended to be used in an automatic toll collection environment, is nonanalogous art. "'In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the invention was concerned.' *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992)." (M.P.E.P. § 2141.01(a).) Applicants fail to see how Hurta is reasonably pertinent to the present invention.

For at least these reasons, claim 1 is patentable over Erlin in view of Hurta and Chaney.

Regarding claims 4, 5, and 10-14, these claims depend directly or indirectly from independent claim 1 and are allowable for at least the same reasons as is independent claim 1 and further in view of their additional distinctive features.

Erlin in View of Hurta, Chaney, and Holtey

Claims 2, 3, 15, and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Erlin in view of Hurta, Chaney, and U.S. Patent No. 5,491,827 to Holtey (hereinafter "Holtey"). (*See*, Office Action at pp. 7-9.) Applicants respectfully traverse these rejections.

Regarding claims 2 and 3, these depend directly or indirectly from independent claim 1. As stated above, none of Erlin, Hurta, or Chaney discloses, teaches, or suggests

"means for interacting with a user's credit or bank card . . . and, separate from said means, a further interacting means for interacting with a user's smartcard to read second information carried by the user's smartcard, said second information being modifiable remotely" as recited in amended independent claim 1. Holtey does not overcome this shortcoming. Therefore, claims 1-3 are patentable over Erlin in view of Hurta, Chaney, and Holtey; and claims 2 and 3 are further patentable in view of their additional distinctive features.

Similar to claim 1, independent claim 15 recites "means to accommodate a credit or bank card carrying a microprocessor . . . and means to accommodate a smart card . . ." As discussed above, none of Erlin, Hurta, Chaney, or Holtey, alone or in combination, discloses, teaches, or suggests these elements in combination in a receiver/decoder for use in a digital satellite television system. Specifically, none of these documents suggests a receiver/decoder that can interact with *both* (1) a *smartcard* and (2) a *credit or bank card*. Therefore, these documents do not "teach or suggest all the claim limitations" as required to establish a prima facie case of obviousness as required to support rejections under 35 U.S.C. § 103(a). (M.P.E.P. § 2142.)

Furthermore, in addition to the "means to accommodate a smartcard," claim 15 specifically recites "means to accommodate a credit or bank card carrying a microprocessor" and "means to interact with said microprocessor." None of Erlin, Hurta, Chaney, or Holtey, alone or in combination, discloses, teaches, or suggests modifying a credit or bank card to carry a microprocessor or means for interacting with such a credit card microprocessor. The Office Action, however, suggests that one skilled in the art would, after absorbing the teachings of Erlin and Chaney, turn to Hurta (which is directed

to Automatic Vehicle Identification and is intended to be used in an automatic toll collection environment) to learn how to modify Erlin to store credit information on a smart card, and look to Holtey to learn how to modify the credit card of Erlin and Chaney to include a microprocessor. Applicants traverse this rejection for the reasons set forth above with respect to claim 1. "The mere fact that references <u>can</u> be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)[.]" (M.P.E.P. § 2143.01.)

For at least these reasons, claim 15 is patentable over Erlin in view of Hurta, Chaney, and Holtey.

Regarding claim 16, it depends directly from independent claim 15 and is allowable for at least the same reasons as is independent claim 15 and further in view of the additional distinctive features of claim 16.

Erlin in View of Hurta, Chaney, and Henderson

Claims 6-9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Erlin in view of Hurta, Chaney, and U.S. Patent No. 5,603,078 to Henderson (hereinafter "Henderson"). (*See*, Office Action at pp. 9-10.) Applicants respectfully traverse these rejections.

Claims 6-9 depend directly or indirectly from independent claim 1. As stated above, none of Erlin, Hurta, or Chaney discloses, teaches, or suggests "means for interacting with a user's credit or bank card . . . and, separate from said means, a further interacting means for interacting with a user's smartcard to read second information

carried by the user's smartcard, said second information being modifiable remotely" as recited in amended independent claim 1. Henderson does not overcome this shortcoming. Therefore, claims 1 and 6-9 are patentable over Erlin in view of Hurta, Chaney, and Handerson; and claims 1 and 6-9 are further patentable in view of their additional distinctive features.

Erlin in View of Hurta, Chaney, and Yu

Claims 17 and 19-21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Erlin in view of Hurta, Chaney, and U.S. Patent No. 5,748,908 to Yu (hereinafter "Yu"). (*See*, Office Action at pp. 4-5.) Applicants respectfully traverse these rejections.

As a first point, Applicants note that both Hurta and Yu are directed to nonanalogous arts that are not within the field of television, radio, or data broadcast and reception systems. (*See*, M.P.E.P. § 2141.01(a).) As stated above, Hurta is directed to Automatic Vehicle Identification and is intended to be used in an automatic toll collection environment. Yu is directed to an expenditure data recording system within a point of sale terminal system.

Regarding independent claim 17, the Examiner argues that one skilled in the art in this field would, after absorbing the teachings of Erlin, Hurta, and Chaney, turn to Yu (which is directed to an expenditure data recording system within a point of sale terminal system) to learn how to verify a remote center. For the same reasons discussed above for claim 1, Applicants traverse this rejection. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior

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art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16

USPQ2d 1430 (Fed. Cir. 1990)[.]" (M.P.E.P. § 2143.01.) For at least this reason, claim

17 is patentable over Erlin in view of Hurta, Chaney, and Yu.

Regarding claim 19, it depends directly from independent claim 17 and is

allowable for at least the same reasons as is independent claim 17 and further in view of

the additional distinctive features of claim 19.

Regarding claims 20 and 21, these depend directly or indirectly from independent

claim 1. Yu does not disclose, teach, or suggest "means for interacting with a user's

credit or bank card . . . and, separate from said means, a further interacting means for

interacting with a user's smartcard to read second information carried by the user's

smartcard, said second information being modifiable remotely". Given this shortcoming,

the Office Action provides no evidence, other than claim 1 itself, as to why one of skill in

the art of broadcast and reception systems would be motivated to combine Yu with the

teachings of Erlin, Hurta, and Chaney and thus fails to establish a prima facie case of

obviousness. Therefore, claims 1, 20, and 21 are patentable over Erlin in view of Hurta,

Chaney, and Yu; and claims 20 and 21 are further patentable in view of their additional

distinctive features.

Erlin in View of Hurta, Chaney, Yu, Merritt, and Hazra

Claim 18 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Erlin

in view of Hurta, Chaney, Yu, U.S. Patent No. 5,475,756 to Merritt (hereinafter

"Merritt"), and U.S. Patent No. 5,787,154 to Hazra *et al.* (hereinafter "Hazra"). (*See*,

Office Action at p. 11.) Applicants respectfully traverse this rejection.

As a first point, Applicants note that at least Hurta, Yu, and Merritt are directed to nonanalogous arts that are not within the field of television, radio, or data broadcast and reception systems. (*See*, M.P.E.P. § 2141.01(a).) As stated above, Hurta is directed to Automatic Vehicle Identification and is intended to be used in an automatic toll collection environment. As stated above, Yu is directed to an expenditure data recording system within a point of sale terminal system. Merritt is directed to transaction execution systems and is intended to be used in an automatic teller machine (ATM) environment.

Regarding claim 18, the Office Action concedes that "Erlin does *not* disclose utilizing a random number." (Office Action at p. 11 (emphasis added).) The present invention relates to a broadcast and reception system. Yet, the Office Action suggests that one of skill in the art in this field would, after absorbing the teachings of Erlin, turn to Merritt (which is directed to transaction execution systems and is intended to be used in an automatic teller machine (ATM) environment) to learn how to verify a remote center using encrypted random numbers, and look to Hazra (which is directed to authentication arrangements for telecommunications system users) to learn how to include a keypad so that a user can input the random number. Applicants traverse this rejection. Again, as stated above with respect to claim 1, "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)[.]" (M.P.E.P. § 2143.01.) For at least this reason, claim 18 is patentable over Erlin in view of Hurta, Chaney, Yu, Merritt, and Hazra.

Erlin in View of Thompson

Claims 23, 24, 33, 36, 37, and 39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Erlin in view of U.S. Patent No. 5,644,345 to Thompson *et al.* (hereinafter "Thompson"). (*See,* Office Action at pp. 5-6.) Applicants respectfully traverse these rejections.

Regarding independent claim 23, neither Erlin nor Thompson discloses, teaches, or suggests "combining the PIN number with a random number". Therefore, these documents do not "teach or suggest all the claim limitations" as required to establish a prima facie case of obviousness as required to support rejections under 35 U.S.C. § 103(a). (M.P.E.P. § 2142.)

The Office Action concedes that "Erlin does *not* disclose combining the PIN with a random number prior to transmission." (Office Action at p. 5 (emphasis added).) However, the Office Action contends that: "Thompson discloses the use of a random number, which is combined with DES encryption (column 7, lines 3-36)." (Office Action at p. 5 .) Applicants dispute this contention. Actually, Thompson discloses that: "The random number is encrypted (or decrypted) using the DES algorithm." (Thompson at col. 7, lines 8-10.) Thus, Thompson does *not* disclose combining the random number with a PIN, but rather discloses *directly encryptimg the random number*. Thus, neither Erlin nor Thompson, alone or in combination, discloses, teaches, or suggests *combining* a PIN with a random number. For at least these reasons, claim 23 is patentable over Erlin in view of Thompson.

Regarding claims 24, 33, 36, 37, and 39, these depend directly or indirectly from

independent claim 23 and are allowable for at least the same reasons as is independent

claim 23 and further in view of their additional distinctive features.

Erlin in View of Thompson, Chaney, Merritt, and Hazra

Claims 27, 30-32, 34, and 35 were rejected under 35 U.S.C. § 103(a) as being

unpatentable over Erlin in view of Thompson, Chaney, Merritt, and Hazra. (*See*, Office

Action at pp. 11-13.) Applicants respectfully traverse these rejections.

As a first point, Applicants note that at least Merritt is directed to nonanalogous

art that is not within the field of television, radio, or data broadcast and reception systems.

(*See*, M.P.E.P. § 2141.01(a).) As stated above, Merritt is directed to transaction

execution systems and is intended to be used in an automatic teller machine (ATM)

environment.

Claims 27, 29-32, 34, and 35 depend directly or indirectly from independent claim

23. None of Chaney, Merritt, or Hazra discloses, teaches, or suggests *combining* a PIN

with a random number as stated in independent claim 23. Both Merritt and the present

application appear to use the term "Personal Identification Number (PIN)" in the same

manner. In Merritt, "When a customer at the bank 1 registers to obtain an account, he is

assigned an account number. . . . The customer then chooses or is assigned a personal

identification number (PIN), which may be, for example, a four-digit number." (Merritt

at col. 3, lines 64-65; and col. 4, lines 6-8.) As the basis for this rejection, however, the

Office Action refers to a section in Merritt that relates to authenticating a terminal (e.g.,

ATM) and host (e.g., bank) to one another. (*See*, Office Action at pp. 12-13; Merritt at

col. 5, lines 18-67 through col. 6, lines 1-20.) This terminal authentication process does

not use a PIN. Rather, the terminal authentication process of Merritt us the *ATM's serial*

number S. (*See,* Merritt at col. 5, lines 18-19.) Therefore, Merritt does not teach

combining a PIN with a random number as stated in independent claim 23. Accordingly,

claim 23 is patentable over Erlin in view of Thompson, Chaney, Merritt, and Hazra, and

claims 27, 29-32, 34, and 35 are allowable for at least this same reason and further in

view of their additional distinctive features.

Conclusion

All of the stated grounds of rejection have been properly traversed,

accommodated, or rendered moot. Applicants therefore respectfully request that the

Examiner reconsider all presently outstanding rejections and that they be withdrawn.

Applicants believe that a full and complete reply has been made to the outstanding Office

Action and, as such, the present application is in condition for allowance. If the Examiner

believes, for any reason, that personal communication will expedite prosecution of this

application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully

requested.

Respectfully submitted,

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